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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,244	09/27/2002	Lynette A. Zaidel	IR 6963-00	2120

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EXAMINER

ROSE, SHEP K

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 06/02/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665244

Applicant(s)

ZAIDEL et al

IR 6963-00

Examiner

SKTSP R. S. S.

Group Art Unit

1614

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 & 26 is/are pending in the application.
Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) 13 & 23 & 26 is/are allowed.
- ☒ Claim(s) 1 & 10 & 13, 14 & 28, 26 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1 & 26 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
 - ☐ received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1614

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 to 10, 13 to 23, 26 are rejected under 35 U.S.C. 102(A/B) as being anticipated by each of Christina Beck et al, Hoic et al, Burke et al, and Gaffar et al (details below).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 to 10, 13 to 23, 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8, 9, 21 and 22 of U.S. Patent No. 5766574. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope, to the same subject matter (details below).

Art Unit: 1614

Christina Beck et al U.S. 5766574 (6/98), (commonly assigned) claims 8, 9, 21 and 22 to such a desensitizing potassium nitrate (or other desensitizing potassium salt) dual component peroxide whitening dentifrice, with first components of such peroxides, and such peroxide compatible abrasives and second components of such peroxide incompatible abrasives and such potassium salt desensitizing compounds, and such first and component PH ranges and PH adjusting agents, lacking only the peroxide reacting dyes in the second component feature recited and required only by claims 11, 12, 24 and 25 herein.

Hoie et al, U.S. 6254857 (7/01) (commonly assigned) can include (paragraph 30) such peroxide compatible and peroxide incompatible abrasives and potassium nitrate, potassium citrate desensitizing agents in the Beck et al U.S. 5766574 (paragraph 9) (or other) dual component whitening dentifrice, with a sensory signal concomitant with whitening of the teeth, lacking only the peroxide reactions dyes in the second component feature recited and required only by claims 11, 12, 24 and 25 herein.

Burke et al U.S. 6126923 (10/00) (commonly assigned) can include (paragraph 26) potassium nitrate desensitizer and whitening agents: hydrogen peroxide, urea peroxide and (paragraph 17) peroxide compatible dicalcium phosphate, calcium pycophosphate abrasives, and peroxide in compatible abrasives: silica, calcined, alumina, sodium bicarbonate, calcium carbonate, in an encompassed species of such a dual component whitening dentifrice, an F.D. & C dyed and colored, striped toothpaste in a partitioned toothpaste tube, as encompassed since it is disclosed on page 13,

Art Unit: 1614

paragraph 41 herein, lacking only the peroxide reactive dye feature recited and required only by claims 11, 12, 24 and 25 herein.

Gaffar et al U.S. 5648064 (7/97) (commonly assigned) can include (paragraph 44) such potassium nitrate or potassium citrate desensitizing agents in such dual component whitening dentifrice with (paragraph 32) such peroxide compatible dicalcium phosphate and calcium pyrophosphate abrasives, as well as peroxide in compatible abrasives: silica, calcined alumina, etc, lacking only the peroxide reactive dye feature of claims 11, 12, 24 and 25 herein.

Prencipe et al U.S. 5256402 (10/93) (commonly assigned) describes dicalcium phosphate and calcium pyrophosphate as peroxide compatible abrasives in tooth whitening peroxide dentifrices with peroxides (paragraph 25) such as urea peroxide or hydrogen peroxide and can include potassium nitrate and potassium citrate desensitizing agent (paragraph 46, claim 9).

Claims 1 to 26 are generic to a plurality of disclosed patentably distinct species comprising one ultimate species of each of :

- (a) A first component peroxide as in claims 2, 3, 15, 16
- (b) a first component peroxide compatible abrasive, as in claims 4, 5, 17, 18
- (c) a second component desensitizing compound, as in claims 6, 7, 19, 20
- (d) a second component peroxide in compatible abrasive
- (e) (if further elected) a second component peroxide-reactive dye as in claims 11 and 12
- (f) (if further elected) a second component PH adjuster of claims 8 and 21

and PH of about 8 to about 13 of claims 13 and 26

- (g) (if further elected) a first component PH of about 4 to about 7 as in claims 13 and 26
- (h) (if further elected) a dual component dentifrice dispensing double barreled springe with a static mixing element, mixing tip, as set forth on page 14, displacing an admixture of the two components.
- (i) (if further elected) a two chamber dispensing container pump or twin partitioned tube with a dispensing outlet storing physically separated components in separate components, as set forth on page 13, (as disclosed in U.S. 4487757 and 4687663).

Synchronously dispensing the separated components as a combined ribbon.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, of each, even though this requirement is traversed. If this application is filed under Rule 371, the legal authority is PCT Rule 13.2, Annex B, part 1 (f) "Markush Practice"; PCT Rule 13 and 35 U.S.C. § 372, rather than 35 U.S.C. § 121.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Election of species is required per MPEP § 803, 809.02 (d) (Markush group claim practice, separate and burdensome fields of search required).

Patentably distinct Markush species are independent inventions, In re Webber, 198 USPQ 328, In re Haas, 198 USPQ 334. Divisional applications may be filed under 35 U.S.C. § 121, as a result of an office requirement for an election of a patentably distinct species as made herein. In re Joyce, 115 USPQ 412, In re Herrick, 115 USPQ 412. This satisfies the "patentably distinct" criterion since the Examiner is not of the opinion that the various species are obviously unpatentable over one another, and each species (as noted above) is capable of independent manufacture, use, and sale, with the other components of the claimed formulations.

Applicant is further required to identify the claims that correspond to the elections as well as those that do not even if the requirements are traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shep Rose whose telephone number is (703) 308-4609. The examiner can normally be reached on Monday, Tuesday, and Thursday 7:30am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Art Unit: 1614

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Rose/tgd
May 27, 2003



SHEP K. ROSE
PRIMARY EXAMINER

Shep Rose
Senior Primary Examiner
Art Unit 1614

Application/Control Number: 10/065,244

Art Unit: 1614

Page 8